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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,491	03/30/2004	Jill Flanick	P/4496-2	3259
2352	7590	09/29/2005	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			RUNNING, RACHEL A	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/812,491

Applicant(s)

FLANICK, JILL

Examiner

Rachel A. Running

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 14-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/30/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-15, drawn to the template, classified in class 132, subclass 214.
  - II. Claims 16-26, drawn to the method of cutting hair, classified in class 132, subclass 200.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the template could be used in a materially different process, such as cutting a straight line on fabric.

2. Applicant's election of Group I in the reply filed on 8/22/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claims 14-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/22/2005.

***Information Disclosure Statement***

4. The "Fringe Kit ©MLIS, Inc. Brochure" filed on 3/30/2004 fails to comply with the provisions of 37 1.98 (b) because it does not contain a date of publication. Therefore, it has been withdrawn from consideration.

***Specification***

1. The disclosure is objected to because of the following informalities: The headings should not be underlined.

Appropriate correction is required.

***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because lines, numbers, and letters are not uniformly thick and well defined, clean, and durable 37 CFR 1.84(i). Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 7, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamilton (U.S. Patent No. 5,427,122). Hamilton discloses a hair-cutting device that has a first side (12) and second side (14) see Figure 1 (column 2, lines 12-14). The first side bearing indicia (68) see Figure 5 (column 3, lines 68-70), and the second side can be adapted to receive an adhesive. Regarding claim 2, the device is made of plastic (column 4, lines 15-16). Regarding claim 3, 4, and 7, the indicia comprises a straight or curved line (68) see Figure 5 (column 3 lines 67-68). Regarding claim 13, the strip of material has a preset length see Figure 1 (column 1, lines 41-42).

5. Claims 1-9, and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Fearn et al. (U.S. Patent No. 6,818,271 B2). Fearn discloses a strip of material having a first side (12) and second side (22) see Figure 2 (column 3, lines 1-3). The first side bearing indicia. Regarding claim 2, the strip is plastic material (column 2, lines 5-6). Regarding claims 3, 4 and 7, the indicia comprises a graphical, straight or curved line

Art Unit: 3732

(14,16) see Figure 1 (column 2, lines 51-56). Regarding claim 5 and 6, the indicia comprises a graphical indicia and an embossment (14, 16) see Figure 2 (column 2, 55-56). Regarding claim 8, the second side comprises an adhesive layer (22) (column 3, lines 1-3). Regarding claim 9, the adhesive layer is protected by a peel-away strip (24) see Figure 2 (column 3, lines 20-25). Regarding claim 13, the strip of material has a preset length.

6. Claims 1-4, 7, 8, and 12 rejected under 35 U.S.C. 102(e) as being anticipated by Meyer et al (U.S. Patent Application 2002/0148134). Meyer discloses a strip of material having a first side (28) (paragraph 0014, lines 1-2) and second side (26) (paragraph 12, lines 1-5). The first side bearing indicia (102) see Figure 2. Regarding claims 3, 4 and 7, the indicia comprises a graphical, straight or curved line (102,104) see Figure 2 (paragraph 15). Regarding claim 8, the second side comprises an adhesive layer (26) (paragraph 12, lines 1-5). Regarding claim 12, the strip of material can be cut to a desired length by the user (paragraph 13, lines 6-7).

7. Claims 1-9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Buell (U.S. Patent No. 5,171,302). Buell discloses a strip of material having a first side (45) (column 6, lines 62-68) and second side (17) see Figure 5 (column 21, lines 43-45). The first side bearing indicia. Regarding claim 2, the strip is plastic material (column 6, lines 62-68). Regarding claims 3, 4 and 7, the indicia comprises a graphical, straight or curved line (23) see Figure 6 (column 23, lines 35-40). Regarding claim 5 and 6, the indicia comprises a graphical indicia and an embossment (23A) see Figure 8. Regarding claim 8, the second side comprises an adhesive layer (column 21, lines 40-

Art Unit: 3732

45). Regarding claim 9, the adhesive layer is protected by a peel-away strip see Figure

5. Regarding claim 13, the strip of material has a preset length.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamilton. Hamilton discloses the claimed invention except the indicia comprising an embossment. However, it would have been obvious to one skilled in the art at the time the invention was made to emboss the indicia to make the graphical markings on the device last longer, because it is well known and readily practiced to add embossment to increase the longevity of indicia.

10. Claims 10 and 11 are rejected under 35 U.S.C. 103(a). It would have been obvious to one skilled in the art at the time the invention was made to cut a line in a peel paper in order to facilitate the removal of the peel-away strip as acknowledged by applicant on page 4, line 4 in reference to an adhesive bandage. It would have been an obvious matter of design choice to make the cut horizontal instead of vertical since applicant has not disclosed that the horizontal cut solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a vertical cut.

**Conclusion**

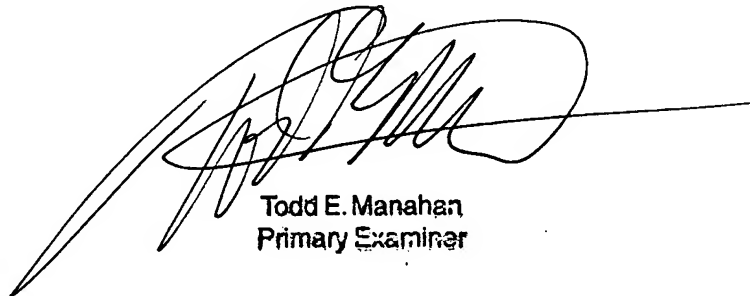
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel A. Running whose telephone number is (571) 272-1917. The examiner can normally be reached on Monday-Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RAR





Todd E. Manahan  
Primary Examiner